REMARKS

Status of Claims

Claims 1 – 5, 7, 8, 11 – 15, 17, and 18 are pending in this application. Applicant respectfully requests reconsideration of claims 1 – 5, 7, 8, 11 – 15, 17, and 18 in light of the following remarks.

Claim Rejections – Rejection under 35 U.S.C. § 112

Claims 1 and 11 are rejected under 35 U.S.C. § 112 as failing to meet the written description requirement.[1] Specifically, the Action states that the claim term "dynamically generating a product identifier using the product parameter identifying and pricing computer when the product is sourced, quoted or ordered, wherein the product identifier is defined by a combination of the product's one or more item parameters, one or more process parameters, one or more artwork parameters and said price," is unsupported by the disclosure of the present application, and its parent, US Patent No. 7,127,415 ("the '415 Patent"). Applicant respectfully traverses the rejection.

The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976); *Ex parte Sorenson*, 3 USPQ2d 1462, 1463 (Bd. Pat. App. & Inter. 1987). The description requirement is simply that the claimed subject matter must be described in the specification. It is not necessary that the application describe the claim limitations exactly, but only so clearly that persons of ordinary skill in the art would recognize from the disclosure that applicant's invention

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[1] Although the Action does not explicitly reference 35 U.S.C. § 112, the Action states: "The instant application does not teach linking or considering the assigned price with the item and process parameters to create a SKU or other identifier," (Action at 3). Claims 1 and 11 recite this feature. Accordingly, Applicant responds to the Action as setting forth a rejection of Claims 1 and 11 pursuant to 35 U.S.C. § 112.

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included those limitations. *In re Smythe*, 480 F.2d 1376, 178 USPQ 179 (CCPA 1973). Applicant respectfully submits that a person having ordinary skill in the art at the time the claimed invention was made would find that the disclosures of the present application and the '415 Patent support Claims 1 and 11, as amended.

In particular, the Action states that the disclosure of the present application and the '415 Patent do not recite "linking or considering the assigned price with the item and process parameters to create a SKU or other identifier," (Action at 3). However, both the specification of the present application and the specification of the '415 Patent describe the claimed steps used to generate various parameters, including price, and using such parameters to generate the product identifier.

First, the claim requires "dynamically generating a product identifier using the product parameter identifying and pricing computer *when the product is sourced, quoted or ordered*, wherein the product identifier *is defined by a combination of the product's one or more item parameters, one or more process parameters, one or more artwork parameters and said price*." The product identifier is thus generated at the same time the requested product is price quoted or ordered, making the generation of the price quote an integral part of the creation of the product identifier. This link is specifically described in Paragraph 0031 which characterizes the invention as follows: "[a] method and system of the present invention may create SKUs (or other identifiers) dynamically. For example, products may be separated into items and processes. Item parameters may be specified. Process parameters may also be specified separately. The item and process parameters may then be linked to create a SKU (or other identifier) when the product is sourced, *quoted*, ordered, or otherwise accessed." (emphasis added) The attention of the Examiner is also directed to Paragraph 0013 which states "[a]nother object of the invention is to

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create SKUs (or other product identifiers) dynamically by separating products into items and processes (or other categories), specifying item parameters, specifying process parameters, dynamically linking an item and process and creating a SKU **when the product is sourced, quoted, or ordered.**" (emphasis added); *See* also Para. [0002] (emphasis added) ("Item parameters and process parameters may be separately specified and linked together to create a unique product where a product identifier (e.g., SKU) may be dynamically created when the product is sourced, *quoted, ordered* or otherwise accessed."). As the Action correctly observes, the product identifier is generated based on one or more item parameters (e.g., type of item, its size, etc.), one or more process parameters (e.g., embossing, etc.), and one or more artwork parameters. (*See* Action at 3.) The disclosure of the present application specifically states that these parameters include "other factors" (i.e., other parameters) beyond the mere aesthetic choices. (*See* Para. [0032].) For example, *quantity-break and other pricing information* is associated with the item parameters. (*See* Para. [0039].) Additionally, process parameters may include *run charges, setup charges and other additional charges.* (*See* Para. [0047].) The price of the branded product is dynamically generated using these item, process, and artwork parameters – including the pricing factors mentioned above. When a unique product identifier is generated by combining the item, process, and artwork parameters with the price, each of these parameters – including related pricing information – is taken into consideration. (S*ee* Fig. 4, 6a, 6b, 8, 10a, 10b, 11, 12a.) The '415 Patent specification states that a "SKU is generated for every vendor partner product *including* variations within a product category." (Col. 4, ll. 25-41) (emphasis added). The specification does not limit the linking of the SKU to *only* product definitions, as suggested by the Action. Instead, the disclosure describes a "SKU database" that stores a SKU for each variation of the product, as defined by the vendor product, **vendor pricing**

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with quantity breaks, net sup costs, etc., vender service and imprinting information. (Col. 4, ll. 25-41). In particular, the specification of the '415 Patent states:

> **The Stock Keeping Unit ("SKU") database** 3010 may include vendor product, **pricing**, service, and imprinting information. **A SKU is assigned to every vendor partner product including variations within a product category**. For example, a blue pen has a different SKU than a red pen. Vendors may enter product information in the SKU database at vendor entry point 3020. Information entered may include general product information; imprinting information based on dynamic product entry; **quantity breaks; net pricing per quantity; net setup costs** by imprint method, number of locations, and number of imprint colors; **net run charges per quantity based on imprint colors; a markup percentage added for each quantity to create their own retail pricing and other similar product information**. Vendors may also enter a flag to delete a product and all associated artwork files. Vendors may upload an original product artwork file at any time for any or all SKUs generated for a product.

(*Id.*, emphasis added). As set forth in the Declaration of David Verchere submitted herewith, one skilled in the art would appreciate from this disclosure that two branded products would have separate entries in this database – and different SKUs – if their prices differed due to, for example, quantity breaks captured in the item parameters.

Accordingly, independent claims 1 and 11, and the claims dependent thereon, are supported by the specification and satisfy the written description requirement of 35 U.S.C. § 112.

Claim Rejections - Rejection under 35 U.S.C. § 103

Claims 1 – 5, 7, 11 – 15, and 17 have been rejected under 35 U.S.C. § 103 as obvious over von Rosen ("von Rosen") in view of Bittel, Lester Robert (Ed.), Encyclopedia of Professional Management, ISBN 0-07-005478-9, pp. 739 and 958 (1978) ("Bittel") in further view of Turbide, David A; "Manufacturing systems", v 14n9 PP: 84-90 Sep 1996 CODEN: MASYES ISSN: 0748-948X JRNL CODE MF ("Turbide").[2]

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[2] Claim 18 has not been rejected under 35 U.S.C. § 103. Applicant therefore respectfully requests a notice of allowance be issued with respect to claim 18.

The test that must be met for a reference or a combination of references to establish obviousness has not been satisfied in the instant matter. The MPEP states, in relevant part, the proper test for obviousness:

> Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103 ...
>
> [T]he four factual inquires enunciated therein as a background for determining obviousness are as follows:
> (A) Determining the scope and contents of the prior art;
> (B) Ascertaining the differences between the prior art and the claims in issue;
> (C) Resolving the level of ordinary skill in the pertinent art; and
> (D) Evaluating evidence of secondary considerations. (MPEP § 2141)

When applying 35 U.S.C. § 103(a), the following tenets of patent law must be followed: 1) the claimed invention must be considered as a whole; 2) the references must be considered as a whole; 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 4) reasonable expectation of success is the standard with which obviousness is determined (MPEP § 2141). None of these criteria have been met here. Among other things, von Rosen in view of Bittel in view of Turbide fail to disclose all of the recited elements of independent claims 1 and 11.

For example, von Rosen in view of Bittel in further view of Turbide does not teach nor suggest a computer implemented method for submitting requests for one or more branded products wherein a user designates features by selecting product parameter data and where item, **process**, artwork and price parameters are identified using the product parameter identifying and pricing computer, linked together, and used to dynamically create a unique product when the product is sourced, quoted, or ordered (*see* Paragraph [0031]). Although the Action maintains that von Rosen discloses a method for creating customized merchandise over a computer network, it does not disclose any mechanism that considers **process** parameters. The Action

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confuses the automated and fixed manufacturing disclosed by von Rosen as equivalent to the claimed process parameters, which allow for customization of the manufacturing process. The present invention, unlike von Rosen, permits a vendor administrator to log-in and select custom processes and process specifications. Von Rosen simply does not teach the ability to create a request that allows for process customization.

Bittel also fails to teach this missing element. Bittel teaches that price could be computed as markups over costs, which "includes the product cost, variable nonproduction costs, and an allocation of fixed costs." Bittel fails to mention processes or process prices in the manner claimed. Accordingly, Bittel, even when combined with von Rosen, fails to teach the use of *process* parameters in the manner claimed. It would not have been obvious for one of ordinary skill in the art to, e.g., separate the process parameters from the product parameters in calculating costs and generating the SKU.

Turbide does not remedy the deficiencies of von Rosen in view of Bittel. As the Action correctly notes, Turbide describes a configuration software that administers a product-definition. When a customer calls in an order, he or she defines a *product* over the phone (*see* Turbide at 1) and Turbide's configuration software defines a bill of materials and routing information according to the customer's specification of the product. Using Turbide's invention, a customer may choose particular elements and their configuration, such as placing a basket on the front of a lawnmower. However, using Turbide's system, a customer cannot choose any process parameters, such as how the basket is attached. In other words, Turbide does not teach the ability to specify process parameters as claimed by applicant, such as attaching an artwork with embossing or screen-printing. It would not have been obvious to one with ordinary skill in the

art to create a computer implemented method for configurating one or more products wherein item, **process**, artwork and price parameters may be **separately specified**, as claimed.

The disclosure of von Rosen also provides no discussion of product identifiers. Von Rosen is directed to creating and ordering merchandise but fails to provide any meaningful discussion of product identifiers that relates in any way to the claimed dynamic creation of a product identifier when the product is sourced, quoted, or ordered. Although Bittel does state that "one of the key materials management issues concerns itself *with the problem of parts and materials standardization*," (Bittel at p. 739), Bittel, does not teach nor suggest any solution to this problem, nor how to create a "good parts numbering system" in relation to customizable products. Bittel merely points out the problem—not the means for solving it. Finally, Turbide fails to remedy the deficiencies of von Rosen in view of Bittel because it does not disclose a method for generating a unique product identifier when the product is ordered, created, or otherwise accessed. Instead, Turbide only discusses the generation of a bill of materials and routing information for a product. A bill of materials defines a product's structure in terms of what materials will be used, while routing information describes the plant resources to be used. *See* SUPPLY CHAIN AND TRANSPORTATION DICTIONARY 32, 250 (4th ed. 2000). The Action incorrectly equates the bill of materials and routing information to a unique product identifier. For example, a bill of materials reciting flour, water, sugar, and yeast and the corresponding routing information reciting an oven could represent a variety of different products such as bread, bagel, or pizza dough. They do not uniquely identify a particular product (e.g., bagel) as claimed.

Turbide also teaches away from the use of unique identifiers such as SKUs. In particular, Turbide states that where a company generates a unique parts number for each variation of a

product, the company often must determine whether the variation is new, manufacturable, functional and meets the company's and customer's requirements. Turbide finds that "this configuration review process not only adds to the turn-around time, but it also ties up engineering talent that could have been used to work on new products . . . [a]nd it's still possible for mistakes to occur and not be discovered." *See* Turbide at *Unique item numbers and bills*. Turbide's configuration software is described as a solution to the shortcomings of using unique identifiers. After reading Turbide, a person having ordinary skill in the art would not have used a unique identifier such as an SKU.

Furthermore, Applicant respectfully submits that the Examiner must consider the declarations submitted on November 7, 2008, August 14, 2008, and herewith as evidence in support of the non-obviousness of the present invention.

First, the Action improperly implies that a person having ordinary skill in the art of the invention is someone possessing expertise in all areas of materials management as well as marketing and business administration. This broad interpretation ignores the intended user and the core purpose of the invention: to provide a valuable bridge between marketing personnel and the manufacturers of promotional goods as set forth in the Declaration of David Verchere filed November 7, 2008 and herewith. (See Para. 6-9). The present invention incorporates several key features that allow the user, possessing the ordinary skill of a marketer/promoter, to be able to obtain remarkably accurate pricing data without having to be an expert in the field of materials management and/or advanced economics. *Id*.

Second, the Action finds that Bittel teaches the linking of price analysis with items, process, and artworks parameters. However, the Action also ignores the declarations filed by David and Lynne Verchere on November 7, 2008, that state that it is beyond the ability of one

skilled in marketing to combine the process discussed in von Rosen and Bittel and arrive at the present invention. (See David Verchere Declaration at Para. 6-9; Lynne Verchere Declaration at Para. 3-4).

Third, the Action fails to consider the Declaration of David Verchere submitted on March 11, 2009, describing the commercial success attributable to the invention. The Action must consider the objective indicia described in the Declaration that would indicate nonobviousness. *See In re Sullivan*, 498 F.3d 1345, 1353 (Fed. Cir. 2007); (MPEP § 716). As an expert in the field, Mr. Verchere's declaration is persuasive evidence which the Examiner must consider. Mr. Verchere's declaration describes in detail numerous examples of promotional product industry members who incorporated the claimed invention into their systems for branding promotional products. For example, Mr. Verchere's declaration offers objective evidence of the industry's acceptance of the claimed invention, as shown by (a) incorporation of the claimed invention into at least fourteen different systems made and sold by industry members; (b) replacement of earlier products such as "online brochures" of promotional products; and (c) copying. Moreover, Mr. Verchere states, *inter alia*, that based upon publicly available information and his many years of industry experience, there is a nexus between the claimed invention and the commercial success of the recited systems, and such nexus is due to the nature of the claimed invention, as opposed to other economic and commercial factors unrelated to the technical quality of the patented subject matter.

Applicant, therefore, respectfully request that the Examiner reconsider and withdraw this rejection.

Conclusion

In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections set forth in the Office Action.

Respectfully submitted,

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